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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,730	03/06/2002	Robert De France	DELRI/109/US	9761

2543 7590 05/17/2002

ALIX YALE & RISTAS LLP
750 MAIN STREET
SUITE 1400
HARTFORD, CT 06103

EXAMINER

FIGUEROA, FELIX O

ART UNIT	PAPER NUMBER
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2833

DATE MAILED: 05/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/091,730

Applicant(s)

DE FRANCE, ROBERT

Examiner

Felix O. Figueroa

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 9-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-8 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-8, drawn to a ground connector, classified in class 439, subclass 100.
- II. Claims 9-13, drawn to a ground installation, classified in class 439, subclass 810.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the assembly does not required the connector having a pair of intersecting surfaces. The subcombination has separate utility such as providing ground connection to a gasoline conduit.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

A telephone call was made to Guy D. Yale on 05/08/02 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Claim Objections

Claim 12 is objected to because of the following informalities: in claim 12 line 1,"3" should be --9--. For the purposed of treating the claim on the merits it would be assumed that claim 12 depends on claim 9, as discussed with applicant's representative, Guy D. Yale, on 05/13/02. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 9, the phrase "vise-type" renders the claim indefinite because the claim includes elements not actually disclosed (those encompassed by "type"), thereby rendering the scope of the claims unascertainable. Please note that the addition of the word "type" to an otherwise definite expression extends the scope of the expression so as to render it indefinite. Ex parte Copenhaver, 109 USPQ 118 (Bd. App. 1955). Ex parte Attig, 7 USPQ2d 1092 (Bd. Pat. App. & Inter. 1986).

Claim 9 recites "a receiving cavity" and "a second guide portion". However, it appears that these limitations are referring to the same part of the present invention, or

in the alternative, that the structural relationship between the two parts is missing. For the purpose of treating the claims on the merits it is assumed that the second guide portion receives the first guide portion. Correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barron (US 4,768,963) in view of Izraeli (US 4,103,986).

Barron discloses a ground connection installation comprising: a transformer (14) having a ground connecting means (12); a base (5) having a spade connector (3) and a fixed jaw (left side of 6, in Fig.2) and a first guide portion (7); a movable member (9) comprising a movable jaw (tip of 11) and a second guide portion (11); wherein the first and second guide portions are configured for sliding engagement to guide longitudinal movement of the movable member with respect to the base; and securement means (threads) for securing the base and the movable member. However, Barron does not disclose the base with the spade connector defining an opening and a bolt extending through the opening.

Izraeli teaches a connector having a base having a spade connector (104) defining an opening (106) and comprising a fixed jaw (52) and a first guide portion (92); a movable member (76) defining a receiving cavity (between 80 & 82) and comprising a

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movable jaw (78) and a second guide portion (84), the second guide portion receiving the first guide portion, wherein the first and second guide portions are configured for sliding engagement to guide longitudinal movement of the movable member with respect to the base; securement means (threads) for securing the base and the movable member; and a bolt extending through the opening to provide an easier installation of the base. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the base for the base assembly, as taught by Izraeli, to facilitate installation of the base to the transformer ground connecting means.

Regarding claims 10 and 11, both Barron and Izraeli disclose a cable secured in the clamp, and a portion of the cable in the clamp being tangential to the transformer housing.

Regarding claim 12, Izraeli disclose the first guide portion and the second guide portion having ribs and cooperating channels.


Regarding claim 13, Barron discloses substantially the claimed invention except for a threaded opening instead of the welded nut. It would have been obvious to one of ordinary skill in the art to use a welded nut instead of a threaded opening, since since applicant has not disclosed that such design solves any stated problem or is for any particular purpose. Absent any convincing showing of the criticality of the design, this particular design is nothing more than the inventor's choice without thereby departing from the scope of the invention. *In re Dailey*, 149 USPQ 47 (CCPA 1976).

Conclusi n

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Felix O. Figueroa whose telephone number is (703) 308-0097. The examiner can normally be reached on Mon.-Fri., 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Bradley can be reached on (703) 308-2319. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.


FELIX O. FIGUEROA
Examiner

ffr
May 13, 2002